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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/590,859	06/08/2000	Steven Casagrande	159008-0003	9867
24267	7590	11/19/2004		
CESARI AND MCKENNA, LLP 88 BLACK FALCON AVENUE BOSTON, MA 02210			EXAMINER KIM, JUNG W	
			ART UNIT 2132	PAPER NUMBER

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/590,859

Applicant(s)

CASAGRANDE, STEVEN

Examiner

Jung W Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 16-36 have been examined. Applicant has canceled claims 1-15 and added new claims 16-36 in the amendment filed on August 6, 2004.

Response to Amendment

2. The objection to the specification is withdrawn as the amendment to the disclosure overcomes the objection.
3. The objection to the title is withdrawn, as the amended title is more clearly indicative of the invention to which the claims are directed.
4. The rejections under 35 U.S.C. 112, second paragraph of claims 1, 3, 5, 11 and 13 are withdrawn as the claims have been canceled.

Response to Arguments

5. Applicant's arguments with respect to new claims 16-36 have been considered but are moot in view of the new ground(s) of rejection.

Drawings

6. The drawings were received on July 30, 2004. These drawings are unacceptable. Replacement drawing sheets must be identified in the top margin as "Replacement Sheet." See revised 37 CFR 1.121 effective June 30, 2003.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 16, 18, 20, 25 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claims 16, 18 and 25 recite the limitation "the set of encrypted single values".

There is insufficient antecedent basis for this limitation in the claims.

10. The term "a number" in claims 20 and 26 is a relative term which renders the claim indefinite. The term "a number" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The quantity or limitation "identical single values" has been rendered indefinite by the use of this term in the claim.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 16-19, 21-25, 27, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matyas et al. U.S. Patent No. 4,757,534 (hereinafter Matyas) in view of Reardon U.S. Patent No. 6,212,635 (hereinafter Reardon) and Fielder et al. U.S. Patent No. 6,049,612 (hereinafter Fielder).

13. As per claim 16, Matyas discloses a process for protecting a software product, sent from a server computer to a computer, from unauthorized usage, the process comprising the steps of:

- a. generating a first set of parameters from the computer and sending the first set of parameters to the server computer before the software product is sent to the computer (see Matyas, Figure 3, 'Computer #', 'Disk #' and 'Prog #'),
- b. creating, at the server computer, a single value before the software product is sent to the computer and encrypting, at the server computer, the software product by using the single value as the encryption key (see Matyas, col. 6, lines 59-62),
- c. sending the encrypted software product to the computer (see Matyas, col. 5, lines 8-9),
- d. encrypting, at the server computer, the single value by using members of the first set of parameters from the computer (see Matyas, col. 6, lines 40-65),

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- e. generating a second set of parameters from the computer and decrypting members of the set of encrypted single values using members of the second set of parameters as decryption keys (see Matyas, col. 8, lines 3-13), and
- f. decrypting the encrypted software product by using the single value as the decryption key (see Matyas, col. 8, lines 13-16).

14. Matyas does not disclose generating the single value from the first set of parameters. Reardon teaches collecting information about a computer configuration and computer network from a user or directly from a CPU and hashing these values to create a unique seed to generate an encryption key. See Reardon, col. 10, lines 40-59. It would be obvious to one of ordinary skill in the art at the time the invention was made to create the single value from the first set of parameters to link an encryption key with the unique profile of a computer. See Reardon, col. 10, lines 54-55.

15. Further, Reardon teaches that the generated single value is used as a key in an asymmetric cryptographic system and not in a symmetric one as claimed. See applicant's amendment, page 13, 1st full paragraph-page 14, 1st paragraph. Fielder teaches using seed values to generate a deterministic symmetric key that is unique to a user. See Fielder, Abstract, 1st sentence and Figure 3. It would be obvious to one of ordinary skill in the art at the time the invention was made for the single value to be generated for use in a symmetric cryptographic system since, symmetric algorithms are more efficient than asymmetric algorithms for encrypting files as known to one of ordinary skill in the art and as taught by Fielder. See Fielder, col. 2, lines 49-53. The aforementioned covers claim 16.

16. As per claim 17, Matyas covers a process as outlined above in the claim 16 rejection under 35 U.S.C. 103(a). In addition, the software product comprises data files or streaming data or both. See Matyas, claim 1. The aforementioned covers claim 17.

17. As per claims 18 and 19, Matyas covers a process as outlined above in the claim 17 rejections under 35 U.S.C. 103(a). In addition, the computer is authorized access to the software product. See Matyas, col. 8, lines 3-16. The aforementioned covers claims 18 and 19.

18. As per claims 21 and 22, Matyas covers a process as outlined above in the claim 16 and 17 rejections under 35 U.S.C. 103(a). In addition, the process includes the step of requesting access to the encrypted software product at the computer, and in response thereto, generates a second set of data from the computer. See Matyas, col. 5, line 62-col. 6, line 10. The aforementioned cover claims 21 and 22.

19. As per claims 23 and 24, they are claims corresponding to claims 21 and 22, and they do not teach or define above the information claimed in claims 21 and 22.

Therefore, claims 23 and 24 are rejected as being unpatentable over Matyas in view of Reardon and Fielder for the same reasons set forth in the rejections of claims 21 and 22.

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20. As per claims 25 and 27, they are claims corresponding to claims 16-19, and they do not teach or define above the information claimed in claims 16-19. Therefore, claims 25 and 27 are rejected as being unpatentable over Matyas in view of Reardon and Fielder for the same reasons set forth in the rejections of claims 16-19.

21. As per claims 31 and 32, they are claims corresponding to claims 16 and 17, and they do not teach or define above the information claimed in claims 16 and 17. Therefore, claims 31 and 32 are rejected as being unpatentable over Matyas in view of Reardon and Fielder for the same reasons set forth in the rejections of claims 16 and 17.

22. Claims 28, 29, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larose et al. U.S. Patent No. 6,108,420 (hereinafter Larose) in view of LeBourgeois U.S. Patent No. 6,026,166 (hereinafter LeBourgeois).

23. As per claim 28, Larose discloses a process for protecting a software product from unauthorized usage by authenticating a computer before the software product is downloaded from a server computer to the computer, the process comprising the steps of:

- a. executing a license agreement by a user for the software product for the computer, before the software product is downloaded to the computer (see Larose, col. 5, lines 21-24),

b. generating a first set of parameters from the computer before the software product is downloaded from the computer and sending the first set of parameters to the server computer before the software product is downloaded to the computer (see Larose, col. 5, lines 24-52),

d. generating a second set of parameters from the computer, comparing the first set of parameters to the second set of parameters, and installing the application if the two sets match (see Larose, col. 12, line 33-col. 13, line 31).

24. Larose does not disclose sending the second set of parameters from the computer to the server before downloading the product to the computer wherein the comparison of the two sets is made at the server. LeBourgeois teaches submitting a second set of parameters to a server from a user prior to executing a transaction and comparing the second set of parameters with a first set of parameters at the server. See LeBourgeois, Figure 1, steps 4 and 5. It would be obvious to one of ordinary skill in the art at the time the invention was made to check current user identity parameters with stored user identity parameters at the server to validate the computer at a local trusted by the provider of the software product as known to one of ordinary skill in the art. The aforementioned covers claim 28.

25. As per claim 29, Larose covers a process as outlined above in the claim 28 rejection under 35 U.S.C. 103(a). In addition, the software product comprises data files or streaming data or both. See Larose, Figure 2, Reference No. 170. The aforementioned covers claim 29.

26. As per claim 33 and 34, Larose discloses a process as outlined above. Although Larose does not expressly teach moving the downloaded software product to a second computer whereupon the second computer is not authorized access to the software product, the invention taught by Larose restricts the copying and sharing of software programs (see Larose, col. 3, lines 17-25), hence these steps are covered by the very act which the invention was designed to prevent: specifically an unscrupulous user transferring a software program from a designated authorized computer to an unauthorized computer, or in more general terms, the proliferation of unauthorized copies of the software. In such a scenario, the invention denies requests to access the software from the unauthorized computer. See Larose, claim 16, step b. The aforementioned covers claims 33 and 34.

27. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Larose in view of LeBourgeois, and further in view of Arnold et al. U.S. Patent No. 5,379,342 (hereinafter Arnold).

28. As per claim 35, Larose covers a process as outlined above in the claim 34 rejection under 35 U.S.C. 103(a). Larose does not expressly disclose displaying a message to the user. Arnold teaches displaying a message to a user when data verification of a computer program fails. See Arnold, col. 5, lines 14-17. It would be obvious to one of ordinary skill in the art at the time the invention was made to display a

message to a user to indicate the failure of a verification step as taught by Arnold and as known to one of ordinary skill in the art. Ibid. The aforementioned covers claim 35.

29. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Larose in view of LeBourgeois, and further in view of Solo U.S. Patent No. 4,562,342 (hereinafter Solo).

30. As per claim 36, Larose covers a process as outlined above in the claim 34 rejection under 35 U.S.C. 103(a). Larose does not expressly disclose automatically notifying the vendor. Solo teaches notifying the vendor when a fraud is detected. See Solo, col. 3, lines 61-64. It would be obvious to one of ordinary skill in the art of fraud/theft notification at the time the invention was made to notify the vendor when a fraud is detected to minimize the repercussions of the theft as known to one of ordinary skill in the art and as taught by Solo. Ibid. The aforementioned covers claim 36.

31. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Larose et al. U.S. Patent No. 6,108,420 (hereinafter Larose) in view of LeBourgeois, and further in view of Aziz U.S. Patent No. 5,604,803 (hereinafter Aziz).

32. As per claim 30, Larose covers a process as outlined above in the claim 28 rejection under 35 U.S.C. 103(a). Larose does not expressly teach the limitation defined in claim 30. Aziz teaches a timeout period for an authenticated user, wherein

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re-authentication is required if the timeout period elapses. See Aziz, col. 2, line 63-col. 3, line 4. It would be obvious to one of ordinary skill in the art the time the invention was made to re-authenticate the computer if the download pauses and the authentication times out to ensure the download is not intercepted by an unauthorized computer. See Aziz, col. 1, lines 33-36 and col. 2, lines 1-12. The aforementioned covers claim 30.

Allowable Subject Matter

33. Claims 20 and 26 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

34. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jung W Kim whose telephone number is (703) 305-8289. The examiner can normally be reached on M-F 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703) 305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jung W Kim
Examiner
Art Unit 2132

Jk
November 8, 2004


GILBERTO BARRON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100